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10/589,458	08/14/2006	Andrew Michael Halliday	67688	7173

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120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

ATKISSON, JIANYING CUI

ART UNIT	PAPER NUMBER
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3742

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,458	Applicant(s) HALLIDAY ET AL.	
	Examiner JIANYING ATKISSON	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 41-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-40, drawn to an insert for use in a beverage preparation machine.

Group II, claims 41-55, drawn to a beverage preparation system.

Group III, claim 56, drawn to a method for dispensing a beverage.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical feature in all groups is making a beverage, and Burrows et al teaches a beverage making machine and method, and an insert used in the machine.

During a telephone conversation with James Kmeger on 2/16/10 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 41-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the inlet and outlet of the brew head". It is not clear if the "the inlet and outlet of the brew head" refer to the "upwardly directed inlet" and "downwardly directed outlet" or different inlet and outlet of the brew head, thus there is insufficient antecedent basis for this limitation in the claim.

The term "generally" in the phrase "generally in an inward direction" in claim 30 and "sufficient" in claim 18 are terms of degree which renders the claim indefinite. The term "generally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 2-40 are rejected since they are dependent on claim 1 and/or claim 30/18.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3742

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Burrows et al. (US 6,634,281), hereafter Burrows.

Regarding claim 1, Burrows teaches an insert (12) for use in a beverage preparation machine (10) of a type comprising a brew head (28) suitable for receiving a rigid or semi-rigid cartridge (cavity 32 can receive cartridge), the brew head comprising an upwardly directed inlet (62) for supplying water to the brew head, a downwardly directed outlet (79) for outflow of beverage produced by the machine, and a closure mechanism (38) moveable between open and closed configurations, the insert comprising a receptacle (12) and sealing means (77), the receptacle having an opening (top opening of 12) through which, in use, a quantity of beverage ingredients (ground coffee, etc) may be loaded into the receptacle, a lower portion of the insert comprising an inlet (64) and an outlet (holes on mash 78), wherein, in use, on insertion of the insert into the brew head of the beverage preparation machine and movement of the closure mechanism into the closed position the sealing means is contactable with, and sealable against, the brew head to thereby close the opening of the receptacle to define a brewing volume containing the quantity of beverage ingredients, and on inserting the insert into the brew head the inlet (64) and outlet (mash holes) of the insert are arranged to communicate respectively with the upwardly directed inlet (62) and the downwardly directed outlet (79) of the brew head such that, in use, water from the inlet

Art Unit: 3742

of the brew head passes upwardly through the inlet of the insert into the brewing volume and such that beverage produced from the water and the quantity of beverage ingredients passes downwardly through the outlet of the insert to flow out of the downwardly directed outlet of the brew head (col. 5, lines 49-54, col. 6, lines 58-62).

Regarding claim 2, Burrows teaches that the insert as claimed in claim 1 wherein the quantity of beverage ingredients (ground coffee) loaded in use into the receptacle are loose (ground coffee is loose).

Regarding claim 3, Burrows teaches that the insert as claimed in claim 2 wherein the insert comprises filtering means (78) between the brewing volume and the outlet of the insert.

Regarding claim 4, Burrows teaches that the insert as claimed in claim 1 wherein the quantity of beverage ingredients loaded in use into the receptacle are contained in a container (inner container formed by 78, Fig. 7) comprising filtering means (12 is a container with filtering means).

Regarding claim 5, Burrows teaches that the insert as claimed in claim 4 wherein the container is flexible (78 is mesh or mash-like and thus flexible).

Regarding claim 6, Burrows teaches that the insert as claimed in claim 5 wherein the container is formed at least in part from a filtering membrane (78 is mesh or mesh-like membrane).

Regarding claim 7, Burrows teaches that the insert as claimed in claim 6, wherein the container is a filter bag (Fig. 7, the portion of 78 is shaped like a bag).

Regarding claim 17, Burrows teaches that the insert as claimed in claim 1, wherein the receptacle is cup-shaped and wherein the cup is upwardly directed when the insert is located in said machine (Fig. 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-13, 18-20, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows.

Regarding claims 8-9, Burrows teaches the limitations of claim 4, but does not teach that the container is a rigid or semi-rigid cartridge.

However since Burrow teaches a beverage machine with brewing head and basket, thus it would have been obvious to a person of ordinary skill in the art at the time of invention to insert a rigid or semi-rigid cartridge of any of semi-spherical, cylindrical, round or square in shape in the brewing basket to make beverages.

Regarding claim 10, Burrows teaches that the opening of the receptacle (12, Fig. 6) is upwardly directed.

Regarding claim 11, Burrows teaches that the insert as claimed in claim 10, wherein the sealing means (77) is located on an upper portion of the insert (Fig. 6).

Regarding claim 12, Burrows teaches that the insert as claimed in claim 11 wherein the sealing means is located on an upper rim of the insert (Fig. 3).

Regarding claim 13, Burrows teaches that the insert as claimed in claim 11, wherein the sealing means is separate from the receptacle (Fig. 6).

Regarding claims 18-20, Burrows teaches the limitations of claim 17, Burrows also teaches that the insert is rigid or semi-rigid, and sufficient force is applied to a cap 77 to close the basket to prevent undesired spilling (col. 6, lines 25-28) (*Regarding claim 18*); an viewing window on cap 77 (col. 7, lines 10-11) (*Regarding claim 19*); and the lower surface of the insert seals against the inlet of the brew head of the beverage preparation machine (col. 5, lines 38-41) (*Regarding claim 20*). Burrow does not teach that said closure mechanism (38) squeezes the insert.

However it would have been obvious to a person of ordinary skill in the art at the time of invention to extend the lid 38 to cover the whole top section of brew head 28 to prevent dust from getting in the cavity 32 and to improve the hygiene; and to leave a window portion for viewing inside the brewing chamber. Thus when pressure is applied to the extended lid to close the lid portion, cap 12 of the insert will be squeezed to seal against the receptacle of 12, and the lower surface of the insert 12 will seal against the inlet of brew head for hot water communication.

Regarding claim 22, Burrows teaches that the insert is formed from more than one piece (77, 12).

Regarding claim 23, Burrows teaches that the wherein the insert is disc-shaped.

Regarding claim 24, Burrows teaches that the insert is formed from plastic (col. 5, line 46).

Regarding claim 25, Burrows teaches that the inlet and outlet of the insert are coplanar.

7. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Cai (US 7,032,503).

Regarding claim 14-15, Burrows teaches the limitations of claims 13, but does not explicitly disclose that the sealing means comprises a ring seal or an O-ring. for sealing around a periphery of the brewing volume.

In the same field of endeavor of beverage brewing machine, Cai teaches a ring seal (25) or O-ring (16) used to form airtight seal for a brewing chamber (col. 3, lines 12-14).

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to use a ring seal or O-ring between the basket 12 and the sealing lid 77 to form airtight connection there-between thus to ensure no hot steam escapes outside to cause unintentional burn for the user.

Regarding claim 16, it is well known that O-rings are commonly made from an elastomeric material.

8. Claims 21, 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows et al. (US 6,634,281), hereafter Burrows, and in view of Halliday et al (US 2004/0197444), hereafter Halliday.

Regarding claim 21, Burrows teaches the limitations of claims 20, but does not explicitly disclose that the insert is formed as one piece.

In the same field of endeavor of beverage brewing machine, Halliday teaches an insert (Figs. 11, 18, 29, 34) with the claimed features of the insert of claim 20 and is formed as one piece.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to make the cap 77 and the receptacle 12 as one piece, thus accurate amount of coffee can be prepackaged, and the insert thus made can be used as cartridges and thus making to increase the convenience and accuracy in coffee making.

Regarding claim 26, Burrows teaches that the insert further comprising an aperture (top opening of 12) for receiving on insertion of the insert in the beverage machine a window of a bar code reader or RFID reader of said machine (a bar code reader can be receive by the top opening of 12).

Regarding claim 27, since the location for the aperture to receive the bar code reader is dependent on the location of bar code, thus it can be located coplanar with the inlet and outlet of the insert.

Regarding claim 28, since the location of the inlet depends on the inlet of the brewer and the relative position of the insert and the brewer, thus the inlet of the insert can be located at or near a periphery of the insert and the outlet of the insert is located at a centre of the insert.

Regarding claim 29, Burrows teaches that the insert as claimed in claim 28, wherein, in use, flow through the insert is from the inlet to the outlet.

Regarding claim 30, Burrows teaches that the insert as claimed in claim 29 wherein, in use, flow through the insert is generally in an inward direction from the inlet to the outlet.

Regarding claim 31, Burrows teaches that the insert as claimed in claim 30, further comprising rotatable means (64 can rotate on 60) for attaching the insert to the beverage preparation machine.

Regarding claim 32, Burrows teaches that the insert as claimed in claim 31 wherein the rotatable means allows the insert to be rotated on closure of the closure mechanism into a horizontal orientation such that a lower surface of the insert is sealed against the inlet of the brew head.

Regarding claim 33, Burrows teaches that the insert as claimed in claim 32 wherein the rotatable means comprises one leg (64) which is attachable to, and rotatable about, one pivot points (62) of the brew head.

Regarding claims 34 and 35, Burrows teaches the limitations of claim 33, but does not teach that the insert that further comprising coding means for controlling operation of said beverage preparation machine.

In the same field of endeavor of beverage brewing machine, Halliday teaches a insert comprising coding means (Fig. 45, bar code 320, par. 0196) for controlling operation of said beverage preparation machine so that the beverage machine can be operated according to the operational parameters can be stored in the barcode to ensure the best quality of the beverages.

Thus it would have been obvious to a person of ordinary skill in the art at the time of invention to include bar code of the insert of Burrow and store operation information in the barcode so to inform the user for the proper operation to ensure the best beverage quality.

Regarding claim 36, Burrows teaches that the insert as claimed in claim 35, wherein the insert is disposable (the insert is disposable after certain period of using).

Regarding claim 37, Burrows in view of Halliday teaches that the inlet and/or outlet of the insert are initially closed by means of a frangible membrane (Halliday, par. 0096).

Regarding claim 38, Burrows in view of Halliday teaches that the insert is reusable.

Regarding claim 39, Burrows in view of Halliday teaches that the opening of the receptacle may be closed by means of a lid (77).

Regarding claim 40, Burrows in view of Halliday teaches that the lid is a push or slide fit with the receptacle (Fig. 6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JIANYING ATKISSON whose telephone number is (571)270-7740. The examiner can normally be reached on Mon-Friday. 9:00-5:00.

Art Unit: 3742

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JIANYING ATKISSON/
Examiner, Art Unit 3742

/Mark H Paschall/
Primary Examiner, Art Unit 3742